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In re Application of :
Theodorus Joseph Aquarius et al : DECISION ON
Application No.: 10/031,111 :
PCT No.: PCT/NL01/00351 : PETITION
Int. Filing Date: 08 May 2001 :
Priority Date: 08 May 2000 : UNDER 37 CFR 1.47(b)
Attorney's Docket No.: A-71266/ESW :
For: DEVICE FOR MANUFACTURING... :
AND TUBULAR FOIL :

This decision is in response to petitioner's "PETITION TO FILE APPLICATION UNDER 37 CFR 1.47(b)" filed on 16 October 2002 that seeks the acceptance of the application without the signatures of joint inventors Pieter Theodorus Joseph Aquarius and Frederik Cornelis Martinus Straver.

BACKGROUND

On 08 May 2001, applicant filed international application PCT/NL01/00351, which claimed priority of an earlier Dutch application filed 08 May 2000. A copy of the international application was transmitted to the United States from the International Bureau on 15 November 2001. No Demand was filed on this application. Accordingly, the twenty-month period for paying the basic national fee in the United States expired at midnight on 08 January 2002.

On 08 January 2002, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1), and a purported translation of the international application. No oath or declaration was submitted at such time.

On 17 April 2002, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 indicating that "the oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. The notification also indicated that the surcharge for filing the oath or declaration later than 20 months from the priority date as required by 37 CFR 1.492(e) must be filed. The notification set two months from the date of this notice or 32 months from the priority date for the application, whichever is later. Failure to properly respond will result in abandonment."

In an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4), applicant filed on 16 October 2002, inter alia, a petition under 37 CFR 1.47(b), the petition fee, a statement in support of petition, and a Declaration and Power of Attorney signed by Arthur Graham (President of Free-Flow Packaging International).

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Petitioner has satisfied items (1), (3), (4) and (6), but not items (2), and (5) thus not completing the requirements under 37 CFR 1.47(b).

Petitioner has satisfied item (1) since the petition fee has been provided by check.

Regarding requirement (2), although petitioner has concluded that Mr. Pieter Theodorus Joseph Aquarius and Frederik Cornelis Martinus Straver have refused to sign the declaration the petition does not include sufficient proof to establish that the inventors refused to execute the application. The standards for proof are set forth in MPEP § 409.03(d), which provides:

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted....

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the non - signing inventor, or, if the non - signing inventor is represented by counsel, to the address of the non - signing inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

The averments of Mr. Wright are insufficient to support a finding that the nonsigning inventors refused to signed the declaration as well as the assignment since a complete set of application papers were not presented to them for their signature. Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventors for their signature. It would appear from Mr. Wright's statements that they were only given the declaration and the assignment to sign and not a complete copy of the application as required by MPEP Section 409.03(d). In addition, no documentary evidence such as certified mail return receipt, cover letter instructions, etc., has been introduced into the file record that the inventors were presented with the declaration let alone the complete application.

Moreover, Mr. Wright does not appear to have first hand knowledge of the facts alluded to paragraphs 6-8 of his statements as required by MPEP Section 409.03(d). Petitioner needs to submit statements, with specific facts on the actions referred to by paragraphs 6-8 by persons who have first-hand knowledge of such facts.

Accordingly, the steps enumerated by Mr. Wright are not sufficient to establish that the inventors refuse to sign the declaration.

Regarding item (3), petitioner has stated the last known address of the inventor:

- 1) Pieter Theodorus Joseph Aquarius
Industrieweg 24
NL-6039 AC Stramproy, The Netherlands
- 2) Frederik Cornelis Martinus Straver
Hilversumseweg 21
NL-1251 EV Laren, The Netherlands

Regarding item (4) a declaration has been provided executed by Mr. Arthur Graham, President of Free-Flow Packaging International, Inc, signing on the behalf of the corporation for the non-signing joint inventors, Pieter Theodorus Joseph Aquarius and Frederik Cornelis Martinus Straver.

Regarding item (5) petitioner has not submitted proof that petitioner has sufficient proprietary interest in the application because no agreement acknowledges ownership of the invention by Free-Flow Packaging International, Inc has been provided.

Regarding item (6) petitioner has presented an adequate showing that the granting of this petition is necessary to preserve the rights of the parties or to prevent irreparable damage that will result if the present patent application is deemed abandoned for failure to submit a signed Oath or declaration of the Inventor.

Accordingly, it is not appropriate to accord the national stage application status under 37 CFR 1.47(b) at this time.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. A translation of the international application and the \$130.00 processing fee as required in response to the decision. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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